



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/901,428	07/09/2001	Craig M. Whitehouse	840.052203	8546
7590	08/17/2004		EXAMINER	
Levisohn, Lerner, Berger & Langsam Suite 2400 757 Third Avenue New York, NY 10017			NGUYEN, KIET TUAN	
			ART UNIT	PAPER NUMBER
			2881	

DATE MAILED: 08/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/901,428	WHITEHOUSE ET AL.	
Examiner	Art Unit		
Kiet T. Nguyen	2881		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 23 July 2003 and 19 May 2004.

2a)  This action is FINAL.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 99 and 115 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 99 and 115 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_.  
\_\_\_\_\_

***Objected Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the first mass resolving spectrometer for selecting parent ions having a first desired mass to charge ratio from an ion stream; the means for subjecting the selected parent ions having a first desired mass to charge ratio to collision induced dissociation to generate fragment ions; means for periodically releasing pulses of the trapped ions into a Time-Of-Flight instrument to detect ions with a second mass to charge ratio; and means for adjusting the delay to improve the duty cycle efficiency of ions with the second mass to charge ratio as recited in claims 99 and 115 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of

the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Rejection Under 35 U.S.C. 112, First Paragraph***

Claims 99 and 115 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification is unclear for reciting the limitations “**the first mass resolving spectrometer for selecting parent ions having a first desired mass to charge ratio from an ion stream**”; “**the means for subjecting the selected parent ions having a first desired mass to charge ratio to collision induced dissociation to generate fragment ions**”; “**means for periodically releasing pulses of the trapped ions into a Time-Of-Flight instrument to detect ions with a second mass to charge ratio**”; and “**means for adjusting the delay to improve the duty cycle efficiency of ions with the second mass to charge ratio**” as recited in claims 99 and 115.

Therefore, the Examiner don't understand what is the device that is used to select parent ions having a first desired mass to charge ratio from an ion stream? What is the device that is used to subject the selected parent ions having a first desired mass to charge ratio to collision induced dissociation to generate fragment ions? What is the device that is used to periodically release pulses of the trapped ions into a Time-Of-

Flight instrument to detect ions with a second mass to charge ratio? And what is the device that is used to adjust the delay to improve the duty cycle efficiency of ions with the second mass to charge ratio?

Additional explanations are needed if applicant insists on including these features in claims 99 and 115 without the introduction of new matter.

Applicant's arguments filed on July 23, 2003 and May 19, 2004 have been fully considered but they are not persuasive.

Applicant argued that:

- 1) Col. 8, lines 55-57 of the "259" patent (or page 15, lines 17-19 of the application); and additional col. 3, line 58 to col. 4, line 2 of the "111" patent disclose the step a);
- 2) Col. 8, lines 1-7 of the "259" patent (or page 14, lines 4-7 of the application); and additional col. 4, lines 5-11 of the "111" patent disclose the step b);
- 3) Col. 8, lines 31-35; col. 14, lines 14-19; col. 14, lines 30-33; col. 18, lines 57-65 and col. 23, lines 14-17 of the "259" patent; and additional col. 4, lines 37-47 and col. 7, lines 21-26 of the "111" patent disclose the step d); and
- 4) Col. 7, lines 36-43; col. 12, lines 10-14; col. 13, lines 1-2 and col. 14, lines 13-17 of the "259" patent (or p. 13, lines 5-12; p. 22, lines 18-19; p. 24, lines 8-10; p. 26, lines 15-19 of the application); and additional col. 7, line 65 to col. 8, line 6 of the "111" patent disclose the step e)

This argument is not persuasive. Since all pointed out in the arguments including the table I filed on July 23, 2003 and May 19, 2004 do not disclose the first mass

resolving spectrometer for selecting parent ions having a first desired mass to charge ratio from an ion stream; the means for subjecting the selected parent ions having a first desired mass to charge ratio to collision induced dissociation to generate fragment ions; means for periodically releasing pulses of the trapped ions into a Time-Of-Flight instrument to detect ions with a second mass to charge ratio; and means for adjusting the delay to improve the duty cycle efficiency of ions with the second mass to charge ratio as recited in claims 99 and 115.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kiet T. Nguyen whose telephone number is 571-272-2479. The examiner can normally be reached on Monday-Friday from 8.00 AM to 6.00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John R Lee, can be reached on Monday-Friday. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
\_\_\_\_\_  
KIET T. NGUYEN  
PRIMARY EXAMINER